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FORM**

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Total Number of Pages in This Submission

12

Application Number

09/875,707

Filing Date

June 5, 2001

First Named Inventor

Dan Kikinis

Art Unit

2617

Examiner Name

Laye, Jade O.

Attorney Docket Number

ISURFTV137

**ENCLOSURES (Check all that apply)**

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Reply to Missing Parts/  
Incomplete ApplicationReply to Missing Parts  
under 37 CFR 1.52 or 1.53

Drawing(s)



Licensing-related Papers



Petition

Petition to Convert to a  
Provisional ApplicationPower of Attorney, Revocation  
Change of Correspondence Address

Terminal Disclaimer



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CD, Number of CD(s) \_\_\_\_\_

☐ Landscape Table on CD

Remarks



After Allowance Communication to TC

Appeal Communication to Board  
of Appeals and InterferencesAppeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)

Proprietary Information



Status Letter

Other Enclosure(s) (please identify  
below):

Postcard

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name

Holland &amp; Knight LLP

Signature

Printed name

Michael J. Buchenhorner

Date

April 21, 2006

Reg. No.

33,162

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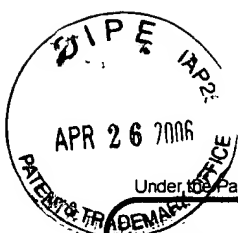
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Date

April 21, 2006

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PTO/SB/17 (01-06)

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# FEE TRANSMITTAL

## For FY 2006

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500.00

**Complete if Known**

|                      |               |
|----------------------|---------------|
| Application Number   | 09/875,707    |
| Filing Date          | June 5, 2001  |
| First Named Inventor | Dan Kikinis   |
| Examiner Name        | Laye, Jade O. |
| Art Unit             | 2617          |
| Attorney Docket No.  | ISURFTV137    |

**METHOD OF PAYMENT (check all that apply)**☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 58-2870 Deposit Account Name: Holland & Knight LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

| Application Type | FILING FEES |                       | SEARCH FEES |                       | EXAMINATION FEES |                       | Fees Paid (\$) |
|------------------|-------------|-----------------------|-------------|-----------------------|------------------|-----------------------|----------------|
|                  | Fee (\$)    | Small Entity Fee (\$) | Fee (\$)    | Small Entity Fee (\$) | Fee (\$)         | Small Entity Fee (\$) |                |
| Utility          | 300         | 150                   | 500         | 250                   | 200              | 100                   |                |
| Design           | 200         | 100                   | 100         | 50                    | 130              | 65                    |                |
| Plant            | 200         | 100                   | 300         | 150                   | 160              | 80                    |                |
| Reissue          | 300         | 150                   | 500         | 250                   | 600              | 300                   |                |
| Provisional      | 200         | 100                   | 0           | 0                     | 0                | 0                     |                |

**2. EXCESS CLAIM FEES****Fee Description**

Each claim over 20 (including Reissues)

| Fee (\$) | Small Entity Fee (\$) |
|----------|-----------------------|
| 50       | 25                    |
| 200      | 100                   |
| 360      | 180                   |

Each independent claim over 3 (including Reissues)

Multiple dependent claims

| Total Claims | Extra Claims | Fee (\$) | Fee Paid (\$) |
|--------------|--------------|----------|---------------|
|--------------|--------------|----------|---------------|

- 20 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of total claims paid for, if greater than 20.

| Indep. Claims | Extra Claims | Fee (\$) | Fee Paid (\$) |
|---------------|--------------|----------|---------------|
|---------------|--------------|----------|---------------|

- 3 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3.

| Multiple Dependent Claims |               |
|---------------------------|---------------|
| Fee (\$)                  | Fee Paid (\$) |

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

| Total Sheets | Extra Sheets | Number of each additional 50 or fraction thereof | Fee (\$) | Fee Paid (\$) |
|--------------|--------------|--|----------|---------------|
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- 100 = \_\_\_\_\_ / 50 = \_\_\_\_\_ (round up to a whole number) x \_\_\_\_\_ = \_\_\_\_\_

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief**Fees Paid (\$)**

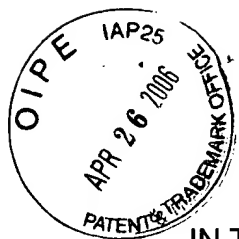
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**SUBMITTED BY**

|                   |                                |                                   |        |           |                |
|-------------------|--------------------------------|-----------------------------------|--------|-----------|----------------|
| Signature         | <u>Michael J. Buchenhorner</u> | Registration No. (Attorney/Agent) | 33,162 | Telephone | 305-789-7436   |
| Name (Print/Type) | Michael J. Buchenhorner        |                                   |        | Date      | April 21, 2006 |

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Dan Kikinis

Art Unit : 2617

Examiner : Laye, Jade O.

Serial No.: 09/875,707

Filed : June 5, 2001

Method and Apparatus for Notifying Users of Interactive Functions

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**BRIEF ON APPEAL**

**(1) Real Party in Interest**

The real party in interest is iSurfTV, Inc., a California corporation which is the assignee.

**(2) Related Appeals and Interferences**

None known.

**(3) Status of Claims**

Claims 1-24 are pending in this case. Claims 1-5, 7-13, 15-21, 23 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis et al (U.S. Patent Application 2005/0028208, hereafter "Ellis") and Sorensen (U.S. Patent 6,628,729, hereafter "Sorensen"). Claims 6, 14, and 22 were rejected under 35 U.S.C. §103(a) as

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April 21, 2006

Date of Deposit

Michael J. Buchenhorner

Signature

Michael J. Buchenhorner

Typed or Printed Name of Person Signing Certificate

having been unpatentable over Ellis in view of Sorensen and further in view of Elliot (U.S. Patent 6,473,097, hereafter "Elliot"). All of the pending claims are being appealed.

**(4) Status of Amendments**

No substantive amendments have been made since the final office action dated November 16, 2005.

**(5) Summary of Claimed Subject Matter**

Claim 1

Claim 1 recites a method comprising transmitting information and receiving information via a wireless connection simultaneously to and from a plurality of hand-held devices. The information interacts with an electronic programming guide (EPG) [specification, page 11, paragraph 39]; indicating an availability of an interactive function in a program corresponding to the EPG simultaneously at said plurality of hand-held devices [specification, page 12, paragraph 43].

Claim 9

Claim 9 relates to a method comprising: transmitting information and receiving information via a wireless connection simultaneously to and from a plurality of hand-held devices, the information interacting with an electronic programming guide (EPG) [page 11, paragraph 39]; and indicating an availability of an interactive function in a program corresponding to the EPG simultaneously at said plurality of hand-held devices [page 12, paragraph 43].

### Claim 16

Claim 16 relates to a machine readable medium having stored thereon a set of instructions, which when executed cause a system to perform a method comprising: transmitting information and receiving information via a wireless connection simultaneously to and from a plurality of hand-held devices, the information interacting with an electronic programming guide (EPG) [page 11, paragraph 39]; and indicating an availability of an interactive function in a program corresponding to the EPG simultaneously at said plurality of hand-held devices [page 12, paragraph 43].

### **(6) Grounds of Rejection to be Reviewed on Appeal**

The grounds of rejection to be reviewed on appeal are:

1. Did the examiner properly reject claims 1-5, 7-13, 15-21, 23 and 24 under 35 U.S.C. §103(a) as having been unpatentable over Ellis et al (U.S. Patent Application 2005/0028208, hereafter "Ellis") and Sorensen (U.S. Patent 6,628,729)?
2. Did the examiner properly reject claims 6, 14, and 24 under 35 U.S.C. §103(a) as having been unpatentable over Ellis and Sorensen further in view of Elliot (US Patent No. 6,473,097)?

### **(7) Argument**

#### **(a) Obviousness:**

The Examiner erred in rejecting claims 1-5, 7-13, 15-21, 23 and 24 under 35 U.S.C. §103(a) as having been unpatentable over Ellis and Sorensen. Claim 1 requires a unit to transmit information and to receive information via a wireless connection; a

plurality of hand-held devices capable of simultaneously communicating with said unit, wherein each apparatus comprises a control unit to interact with an electronic programming guide (EPG) and an indicator to indicate an availability of an interactive function in a program corresponding to the EPG.

Ellis relates to a system that allows a user to adjust the user settings of a plurality of program guides. See Ellis at Paragraphs 12 and 13. Thus, a user may adjust his favorite settings in the family room and may direct the system to apply these settings to the family room and the living room. See Ellis at paragraph 26. Therefore, Sorensen neither teaches nor suggests "a plurality of hand-held devices capable of simultaneously communicating with said unit." Rather Sorensen teaches communicating with a plurality of entertainment units.

The Examiner admits that "Ellis fails to disclose the remaining limitations of claim 1." See Final Office Action at page 3. However, the Examiner contends that Sorensen teaches "indicating the availability of interactive data..." See Final Office Action at page 3. A close look at Sorensen shows that Sorensen contains no such teaching. Sorensen does not teach or suggest "indicating an availability of an interactive function." Sorensen is directed to a portable data storage device which receives and stores data from a receiver. Col. 1, lines 7-10. Sorensen discloses that a digital receiver such as a digital TV receives a digital broadcast signal and separates the data from the signal. Col. 1, lines 50-67. Thereafter, a portable storage device such as a personal digital assistant (PDA) receives the data from the digital receiver and stores the same in its memory. Col. 1, lines 61-67. The data may comprise TV commercial, internet data

such as a uniform resource locator (URL), or data for generating a coupon. Col. 1, 30-40; Col. 2, lines 61-66. Sorensen provides that after the PDA stores the data, a tone, a beep, a light emitting diode flash, or other form of alert may be generated to alert the user that the data has been stored. Col. 3, lines 22-36. Sorensen further discloses that when internet content is detected by a TV controller, it may provide a prompt to the user via a signal transmitted to the PDA in order to initiate local prompt by the PDA. Col. 3, lines 47-54. However, this is different from the presently claimed invention which is capable of simultaneously communicating with a plurality of hand-held devices. Furthermore, Sorensen merely teaches prompting a user when data such as a TV commercial, internet data, specifically a URL, or data for generating a coupon is provided. On the other hand, Applicant's presently claimed invention provides an indication of an availability of an interactive function in a program corresponding to the EPG. Sorensen neither teaches nor suggests the presently claimed invention.

Moreover, the Examiner's conclusion to combine the Elliot and Sorensen references is also an error of law. The Examiner states that it would have been obvious to one of ordinary skill in the art to combine Elliot and Sorensen "in order to provide a device capable of alerting a user to the presence of interactive broadcast data corresponding to an EPG, thereby providing a remote with extended functionality." "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *Id. Ecolochem v. Southern California Edison*, 228 F.3d 1361 (Fed. Cir. 2000).

A piecemeal reconstruction of the prior art patents in light of the applicant's disclosure shall not be the basis for a holding of obviousness. *In re Kamm*, 172 USPQ 298 (CCPA 1972). Thus, it is impermissible within the framework of section 103 to pick and choose from any one reference only so much as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Kamm*, 172 USPQ at 302. In the instant case, the Examiner did not cite any evidence of the reason to combine. Therefore, no *prima facie* case of infringement has been made.

Claims 2-5, 7-13, 15-21, 23 and 24 are patentable for at least the same reasons as discussed above with respect to claim 1.

The examiner erred in rejecting claims 6, 14, and 24 under 35 U.S.C. §103(a) as having been unpatentable over Ellis and Sorensen further in view of Elliot. Claims 6, 14 and 22 all recite a web phone as the remote control in the entertainment system.

As discussed above, Ellis and Sorensen do not teach or suggest the limitations of claims 1. Elliott is directed to an IP intranet functionality in a Mobile Switching Center for supporting wireless data and multimedia services that is introduced between a multimedia device and the internet. Col. 4, lines 48-52. Elliott is an inapposite prior art because it is directed to a field of endeavor different from the presently claimed invention. Elliott neither teaches nor suggests using a web enabled phone to make EPG selections. It makes no suggestions relating to entertainment systems. The Examiner cites no evidence of a teaching, suggestion or motivation. Deficiencies of



Applicant : Kikinis  
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cited references cannot be remedied by the Board's [or Examiner's] general conclusions about what is "basic knowledge" or "common sense" to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001). Therefore, no *prima facie* case of obviousness has been made.

The brief fee of \$500 is enclosed. Please apply any other charges or credits to Deposit Account No. 50-2870.

Respectfully submitted,

Date: April 21, 2006

Michael J. Buchenhorner  
Michael J. Buchenhorner  
Reg. No. 33,162

## Appendix of Claims

1. An entertainment system comprising:
  - a unit to transmit information and to receive information via a wireless connection;
  - a plurality of hand-held devices capable of simultaneously communicating with said unit, wherein each apparatus comprises a control unit to interact with an electronic programming guide (EPG) and
  - an indicator to indicate an availability of an interactive function in a program corresponding to the EPG.
2. The entertainment system of claim 1, wherein the indicator is displayed on a display of the apparatus.
3. The entertainment system of claim 2, wherein the display changes background colors to indicate the availability of the interactive function in the program corresponding to the EPG.
4. The entertainment system of claim 2, wherein the display flashes to indicate the availability of the interactive function in the program corresponding to the EPG.
5. The entertainment system of claim 1, wherein the apparatus is a personal digital assistant.
6. The entertainment system of claim 1, wherein the apparatus is a web phone.
7. The entertainment system of claim 1, wherein the indicator is a unit that generates a sound to indicate the availability of the interactive function in the program corresponding to the EPG.

8. The entertainment system of claim 1, wherein the indicator is a section of the apparatus that illuminates to indicate the availability of the interactive function in the program corresponding to the EPG.

9. A method comprising:

transmitting information and receiving information via a wireless connection simultaneously to and from a plurality of hand-held devices, the information interacting with an electronic programming guide (EPG); and

indicating an availability of an interactive function in a program corresponding to the EPG simultaneously at said plurality of hand-held devices.

10. The method of claim 9, wherein the indicating includes displaying an indicator on a display of the apparatus.

11. The method of claim 10, wherein the indicating includes changing the background colors of the display to indicate the availability of the interactive function in the program corresponding to the EPG.

12. The method of claim 10, wherein the indicating includes the display flashing to indicate the availability of the interactive function in the program corresponding to the EPG.

13. The method of claim 9, wherein the apparatus is a personal digital assistant.

14. The method of claim 9, wherein the apparatus is a web phone.

15. The method of claim 9, wherein the indicating includes generating a sound to indicate the availability of the interactive function in the program corresponding to the EPG.

16. The method of claim 9, wherein the indicating includes illuminating a section of the apparatus to indicate the availability of the interactive function in the program corresponding to the EPG.

18. A machine readable medium having stored thereon a set of instructions, which when executed cause a system to perform a method comprising:

transmitting information and receiving information via a wireless connection simultaneously to and from a plurality of hand-held devices, the information interacting with an electronic programming guide (EPG); and

indicating an availability of an interactive function in a program corresponding to the EPG simultaneously at said plurality of hand-held devices.

19. The machine readable medium of claim 17, wherein the indicating includes ~~is~~ displaying an indicator on a display of the apparatus.

20. The machine readable medium of claim 18, wherein the indicating includes changing the background colors of the display to indicate the availability of the interactive function in the program corresponding to the EPG.

21. The machine readable medium of claim 18, wherein the indicating includes the display flashing to indicate the availability of the interactive function in the program corresponding to the EPG.

22. The machine readable medium of claim 17, wherein the apparatus is a personal digital assistant.

The machine readable medium of claim 17, wherein the apparatus is a web phone.

23. The machine readable medium of claim 17, wherein the indicating includes a unit of the apparatus generating a sound to indicate the availability of the interactive function in the program corresponding to the EPG.

24. The machine readable medium of claim 17, wherein the indicating includes a section of the apparatus illuminating to indicate the availability of the interactive function in the program corresponding to the EPG.

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